

REMARKS

Applicant has carefully considered the Examiner's Office Action and has amended the claims further to define the invention in clearer form and to distinguish patentably from the prior art.

In amending the base claim 1, applicant has cancelled the expression, "stepless variable," which the Examiner has objected to.

The base claim 1 has also been further amended to include the subject matter and limitations that are clearly not to be found in the prior art.

Applicant is also presenting new claims 10 and 11 for consideration by the Examiner.

In considering the reference patent to Nezu (5,996,748) the Examiner appears to consider that the element 15 in Figure 1 of this reference patent is a constant or fixed bypass with a non-variable flow cross-section, and which is hydraulically in parallel with the flow regulating system. This is entirely incorrect.

Thus, as clearly described in applicant's specification and drawings of particularly Figures 1, 2, 3 and 4, applicant's fixed bypass valve connects directly the chambers 8 and 9 of the dashpot. This arrangement is not to be found in the reference patent to Nezu. In this reference patent the element 15 is connected with the element 16, as well as the element 17 and element 12. This means that in no event, the element 15 can be considered to be a fixed bypass valve which is hydraulically in parallel with the valve arrangements.

Instead, as shown clearly in Figure 1 of the reference patent to Nezu, the element 15 is hydraulically connected in series with the primary damping valve 12 of the damping force adjusting valve 17.

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Accordingly, it is clear that the reference patent to Nezu does not at all disclose a constant bypass in the sense of applicant's invention.

As clearly described in applicant's specification, on the other hand, on page 3, second paragraph, applicant provides a fixed bypass valve that can be integrated into the flow-regulating system and which has minimal passage for hydraulic fluid and prevents the dashpot from being entirely blocked when the regulating valve is closed.

The preceding function cannot be fulfilled through the element 15 which the Examiner has incorrectly considered to be a constant bypass valve.

As clearly disclosed in the reference patent to Nezu in Figure 1, the element 15 is in no case a constant bypass between the two chambers 2a and 2b when the primary damping valve 12 is closed or the damping force adjusting valve 17 is closed. This is correctly shown in the patent to Nezu where the element 15, as described in column 7, lines 49 to 55, is hydraulically in series with the elements 13, 12 and 17.

Accordingly, it is evident that the reference patent to Nezu differs clearly from applicant's invention. In particular, the patent to Nezu does not at all disclose a fixed bypass valve with a constant opened flow through cross-section, and this function cannot be achieved through this patent to Nezu. Furthermore, Nezu does not show a fixed bypass valve with constant open flow cross-section which is hydraulically in parallel with the valves of the flow regulating system. The element 15 which the Examiner incorrectly views to be a fixed bypass valve, is actually hydraulically in series with the valves.

The element 15 of the patent to Nezu cannot at all achieve applicant's object with a fixed bypass valve. It is not possible to arrive at applicant's arrangement with the disclosure in the reference patent to Nezu.

It is submitted that applicant provides for a new and marked improvement over the prior art.

Since the claims in the application define clearly the differences between applicant's invention and the prior art reference patent to Nezu, it is believed that the claims should be found allowable.

The Examiner's attention is respectfully directed to the court decision in the case of *In re Bisley* (94 U.S.P.Q. 80, 86), in which the Court decided that patentability is gauged not only by the extent or simplicity of physical changes, but also by the perception of the necessity or desirability of making such changes to produce a new result. When viewed after disclosure, the changes may seem simple and such as should have been obvious to those in the field. However, this does not necessarily negate invention or patentability. The conception of a new and useful improvement must be considered along with the actual means of achieving it in determining the presence or absence of invention. The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability.

In the case of *ex parte Chicago Rawhide Manufacturing Company* (226 U.S.P.Q. 438), the Patent Office Board of Appeals ruled that the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal, is not by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device. The Examiner has not presented any evidence to support the conclusion that a worker in this art would have had any motivation to make the necessary changes in the reference device to render the here-claimed device unpatentable.

In the case of United Merchants and Manufacturers Incorporated versus Ladd (139 U.S.P.Q. 199), the District Court ruled that although from simplicity of device and with advantage of hindsight, one might off-handedly be of opinion that anyone should have been able to make invention after studying prior art, claims are allowed since none of the references discloses or suggests the concept which is the crux of the invention.

Finally, in the case of Menge and Drissen (181 U.S.P.Q. 94), the Court ruled that progress in crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage; constitution envisages and seeks progress in useful "arts," not just in those more esoteric or scientific.

In view of the amendments to the claims, and in view of the preceding remarks, it is respectfully requested that the claims in the application be allowed and the case be passed to issue.

Respectfully submitted,

I hereby certify that this document is a true and correct copy of the original as submitted with the United States Patent Office and that it is a true and correct copy of the original as submitted to the Commissioner of Patents and Trademarks, Washington, D. C. 20231, on 12-23-04
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